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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,168	09/19/2003	Phillip Martin Gibbs	5490-000301	7099

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Stephen J. Foss  
Harness, Dickey & Pierce, P.L.C.  
P.O. Box 828  
Bloomfield Hills, MI 48303

EXAMINER
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SNOW, BRUCE EDWARD

ART UNIT	PAPER NUMBER
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3738

MAIL DATE	DELIVERY MODE
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08/01/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/666,168

Applicant(s)

GIBBS ET AL.

Examiner

Bruce E. Snow

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 35-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13, 35-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                            |                                                                                         |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                           | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## DETAILED ACTION

### *Response to Arguments*

Applicant's amendments and arguments filed 5/17/07 have been fully considered. Regarding applicant arguments about the combination rejection of DE 93122150 and Noiles, the Examiner position is explained in the grounds of rejection below.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 35, 37, 38 are rejected under 35 U.S.C. 102(b) as being anticipated by Herbert (DT 2300810, applicant submitted).

Herbert teaches:

35. (Currently Amended) A prosthetic joint for replacement of a natural joint, the prosthetic joint comprising:

a first prosthesis member 11 including an internal concave portion 13 defining an internal concave diameter;

a second prosthesis member 15 defining a junction portion 20 centered on and formed around a first axis having a selected diameter and defining at least one

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cylindrical portion 18 having a central axis the same as the first axis about at least a portion of a selected equator of said second prosthesis member;

wherein said second prosthesis member is adapted to be implanted into said internal concave portion during an operative procedure;

wherein said cylindrical portion is operable to substantially ensure contact with less than the entire internal concave portion.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 35-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Germany (DE 9312150, applicant submitted). Referring to all figures and embodiments, specifically figure 1 for discussion, DE 93122150 teaches:

39. (Currently Amended) A prosthesis for replacement of an anatomical portion, comprising:

a first prosthesis member 4 including an internal concave portion defining an internal concave diameter; and

a second prosthesis member 14 defining a junction (bore 13) having a first diameter substantially equal to said internal concave diameter and defining at least a

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portion 18, 16, 43 of an equator having a second diameter about the first axis less than said first diameter;

wherein said second prosthesis member is adapted to be implanted into said internal concave portion during an operative procedure;

wherein said equator substantially eliminates complete contact of said second prosthesis member with said first prosthesis member.

However, Germany fails to teach the junction portion is centered on and formed around a first axis. Applicant's specification, paragraph 0022, teaches, the "*equator around which the depressed equator 28 is formed may be any equator and may be of an angle to a central axis of the femoral head 16.*" At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to make the configuration as claimed. Applicant has not disclosed that the junction portion centered on and formed around the first axis being the same axis as the cylindrical portion provides an advantage, is used for a particular purpose, or solve a stated problem (paragraph 0022). One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with either what Germany teaches or the claimed configuration because both lock the second prosthesis in the first prosthesis. Therefore, it would have been obvious to one of ordinary skill in the art to modify Germany's device to obtain the invention as specified in the claim.

Claim 36, element 4 is interpreted as a liner.

Claims 37 and 39, In addition to it would have been obvious to modify as stated above, the use of femoral balls which have a chamfer or don't have a chamfer are both

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well known in the art. It would have been obvious to one having ordinary skill in the art to have utilized a ball which does not have the chamfer as is well known in the art making a cylindrical equator that extends around the entire circumference.

All other claim limitations are self-evident..

Claims 1-13 and 35-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Noiles (4,978,356) in view of Germany (DE 9312150, applicant submitted).

Referring to at least figures 26-30, Noiles teaches a prosthetic joint for replacement of a natural joint to resist dislocation comprising:

a liner 12 including an internal concave portion defining an internal concave diameter, and defining an opening having a passage width smaller than said internal concave diameter;

a ball portion 10 having a ball diameter substantially equal to said internal concave diameter, and a constraining ring 120 cooperating with said opening,

However, Noiles is silent regarding said ball portion having a cylindrical equator having a diameter to said passage width.

Germany teaches a similar prosthetic joint for replacement of a natural joint to resist dislocation comprising ball 14 having a cylindrical equator 18. It would have been obvious to one having ordinary skill in the art to have utilized the teachings of Germany wherein the ball has a cylindrical equator with the ball of Noiles such that the liner, cup, and retaining ring could be pre-assembled when found desirable by the surgeon and the

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ball could easily enter the opening passage in an un-anatomical position and lock in an anatomical position within the liner. Note that Noiles teaches ball 10 is of the configuration which does not include a chamfer; the resulting combination of Noiles and Germany would produce a cylindrical equator that extends around the entire circumference.

Regarding the claims requiring the junction portion centered on and formed around the first axis being the same axis as the cylindrical portion: Applicant's specification, paragraph 0022, teaches, the *"equator around which the depressed equator 28 is formed may be any equator and may be of an angle to a central axis of the femoral head 16."* Applicant has not disclosed that the junction portion centered on and formed around the first axis being the same axis as the cylindrical portion provides an advantage, is used for a particular purpose, or solve a stated problem (paragraph 0022). One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with either what Germany teaches or the claimed configuration because both lock the second prosthesis in the first prosthesis. Therefore, it would have been obvious to one of ordinary skill in the art to modify the device of Noiles in view of Germany to obtain the invention as specified in the claim.

Regarding at least claim 2, note cup 64 having fixation member 64 (see figure 34 and 15:25 et seq.) extending from the exterior surface.

### **Conclusion**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruce E. Snow whose telephone number is (571) 272-4759. The examiner can normally be reached on Mon-Thurs.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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**BRUCE SNOW**  
PRIMARY EXAMINER